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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,073	10/17/2001	Robert A. Aekins	695695.0086	8240

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EXAMINER

HAMMOND, BRIGGITTE R

ART UNIT	PAPER NUMBER
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2833

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/982,073

Applicant(s)  
Aekins et al.

Examiner  
Brigitte R. Hammond

Art Unit  
2833



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 21, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jan 29, 2002 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10 & 1 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. This action is in response to applicant's election received on April 24, 2003 and filed as Paper No. 14. Applicant's election of Group I, claims 1-14 with traverse is acknowledged.

#### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "T" and "R". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

3. Claims 1 and 14 are objected to under 37 C.F.R. Rule 1.75(d)(1). The terms and the phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. In particular, the connector devices, Correction is required.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

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the invention. It is unclear to the examiner exactly what the support mem comprises. For examination purposes the examiner shall assume upper and lower portions 12 and 14. It is also unclear what are the connector devices. For examination purposes the examiner shall assume connector pin.

6. Claim 1 recites the limitation "the data" in line 1; claim 8, line 1 recites "the connecting devices"; claim 9, line 2 recites "the eight leads" and claim 14, lines 1-2 recites "the first row connecting devices" and "the second row connecting devices". There is insufficient antecedent basis for these limitations in the claims.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

8. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Arnett et al. Arnett et al. disclose an insert 28 comprising: a dielectric support member 30 having a plurality of pairs of electrically conductive elongated members 32, each elongated member having a front end

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portion 34 including a contact portion 41 a rear end portion 40 including an electrically conductive connector device 42, wherein the plurality of pairs of elongated members are disposed on the support member in positional relationships with respect to each other such that a capacitance is formed for compensating electrical noise during transmission of a signal.

Regarding claim 2, the plurality of pairs of elongated members have substantially multilaterally symmetrical portions and substantially multilaterally asymmetrical portions (see fig 4).

Regarding claim 3, the front end portions are substantially multilaterally symmetrical and the rear end portions are substantially multilaterally asymmetrical (see fig 4).

Regarding claim 4, the front end portions are substantially parallel.

Regarding claims 5 and 6, each pair of the plurality of pairs of elongated members include a ring member R1 and a tip member T1, wherein the rear end portions of the ring members are lower relative to the receiving space than the front end portions of the ring members and there are four pairs of electrically conductive elongated members.

Regarding claim 7, the front end portions of the elongated members further comprise arcuate sections (see fig 4) for extending the elongated members into the receiving space.

Regarding claim 8, the connecting devices comprise electrically conductive pins 42.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 9,10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Arnett et al. Arnett et al. disclose the invention substantially as claimed except for the insert being used for a RJ45 wire plug. Arnett et al. disclose an insert 28 comprising: a dielectric support member 30 having eight electrically conductive elongated members 32, each elongated member having a front end portion 34 including a contact portion 41 a rear end portion 40 including an electrically conductive connector device 42, wherein the plurality of pairs of elongated members are disposed on the support member in positional relationships with respect to each other such that a capacitance is formed for compensating electrical noise during transmission of a signal.

Regarding claim 10, the front portions of the eight conductive elements are in a substantially parallel positional relationship along a longitudinal axis (see fig 4).

Regarding claim 12, the front end portions are substantially arcuate (see fig 3).

Regarding claims 13 and 14 , the eight elements comprise four ring elements R1 and a four tip elements T1, wherein the ring elements are disposed in a first row and the tip elements are disposed on the second row on the support member, wherein connecting devices on the first row are below the connecting devices of the second row (see fig 3).

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arnett et al. in view of Pharney et al. 6,086,428. Arnett et al. disclose the invention substantially as claimed except for the rear portions including transverse portions with respect to the longitudinal axis.

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However, Pharney et al. disclose rear portions including transverse portions with respect to the longitudinal axis (see fig 3B, terminals 1 and 8). Therefore, it would have been obvious to one of ordinary skill to modify the insert of Arnett et al. by forming the rear portions with transverse portions to conform to the housing cavities as taught by Pharney et al.

***Response to Restriction Arguments***

12. Applicant's arguments filed April 21, 2003 have been fully considered but they are not persuasive. In response to applicant's argument that no "serious burden would be placed upon the examiner". The examiner replies that restriction under 35 USC 121 requires that 1). The inventions are distinct, each from the other because of the following reasons: Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as **claimed does not require the particulars of the subcombination** as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the arrangement does not require an insert. The subcombination has separate utility such as the insert can be used in any modular jack, for example an RJ45 jack.

13. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is **proper and final**.

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### **Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brigitte R. Hammond whose telephone number is (703) 305-0032.

The examiner can normally be reached on Monday - Thursday from 7:30 A.M. to 5:00 P.M. The examiner can also be reached on alternate Fridays.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Brigitte R. Hammond

June 19, 2003

  
P. AUSTIN BRADLEY  
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